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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/813,323 03/10/97 BALTIMORE D 50659/JPW/JM

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HM12/0218

EXAMINER

EYLER, Y

ART UNIT

PAPER NUMBER

1642

18

DATE MAILED:

02/18/00

**Please find below and/or attached an Office communication concerning this application r
proceeding.**

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
08/813,323

Applicant(s)
Baltimore et al.

Examiner
Yvonne Eyer

Group Art Unit
1642



☒ Responsive to communication(s) filed on Dec 13, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 3-20 and 92 is/are pending in the application.

Of the above, claim(s) 5-20 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 3, 4, and 92 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Response to Amendment

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3-20 and 92 (new claim 21 submitted with the amendment of 12/13/99 and renumbered under Rule 1.26) are pending in the application. Claims 3, 4 and 92 are under consideration.

Claim Rejections Withdrawn:

1. The rejection of Claims 1, 3, and 4 under 35 U.S.C. 102(a) as being anticipated Cheng et al. (Science 267:11494-1498, March 10, 1995-IDS) is withdrawn in light of the 1.132 declaration of Dr. Lederman and the cancellation of claim 1.
2. The rejection of Claims 1, 3, and 4 under 35 U.S.C. 102(a) as being anticipated by Hu et al. (J. Biol.Chem. 269:30069-30072, Dec. 1994-IDS) is withdrawn in light of the cancellation and amendments to the claims.

Claim Rejections Maintained and New Grounds of Rejection:

3. New Claim 92 and dependent claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

New base claim 92 still refers to Figure 1. The claim now includes a SEQ ID NO. but it is improper to refer to a Figure within the body of a claim.

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The recitation of “a protein which comprises amino acids, the amino acid sequence of which...” found in new base claim 92 is vague and indefinite. It cannot be determined if the language describing the protein is open or closed. Is the language meant to indicate the protein is made of amino acids and then further described by the rest of the claim, or is the recitation “the amino acids sequence of which” referring to the amino acids comprising the protein. The antecedent basis for “the amino acid sequence” is lacking and the referral of which following it is unclear. In light of the indefiniteness of the language, the protein will be read as open, comprising the parameters of (a), (b), (c), and (d).

The recitation at line 5 of claim 92 “a proline corresponding to the proline shown at position number 564 in SEQ ID NO: 1” is vague and indefinite because the meaning cannot be determined. A proline is a proline, and it is not clear what characteristics a proline must possess in order to correlate to the specific proline indicated. Similarly, the meaning of an amino acid corresponding to Ser 324 cannot be determined either.

4. New claim 92 and dependent Claims 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Sato et al. (Febs Lett. 358:113-118, Jan. 23,1995) for reasons of record in the office actions of 8/18/98 and 6/4/99.

Applicant argues that Sato et al. does not teach the truncated protein as claimed but only disclose structural characteristics of the larger protein or a cDNA that encodes little more than the TRAF domain, but from which protein was not expressed and isolated.

This argument has been considered but is not found to be persuasive.

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It is maintained that Sato et al. teach a protein commensurate in scope with the instantly claimed protein. On page 114, column 2, lines 7-9, a protein comprising residues 363-543 of CAP-1 is set forth. Again on page 115, in Table 1, the pACT-CAP-1 clone 2229 is taught to encode a C-terminal 181 amino acid CAP-1 peptide which is expressed into a protein comprising the instant parameters. Again on page 115, in the legend to Figure 1, in vitro translated CAP-1 peptide of the C-terminal 181 amino acids is taught to be incubated with radiolabel and used in an in vitro binding assay. Page 117, first full paragraph, teaches that the original clone which encoded little more than the TRAF domain encoded residues 384-540, which is the 181 amino acid C-terminal portion. Comparison of the residues of Sato et al.'s truncated peptide and the instantly claimed peptide, or protein comprising, are identical. Sato et al.'s peptide is included in the instant SEQ ID NO: 1. Sato et al.'s peptide contains proline 564 of SEQ ID NO: 1. Sato et al.'s peptide comprises amino acids 414 to 567 of SEQ ID NO: 1, contiguously. Sato et al.'s peptide does not extend past residue 324 of SEQ ID NO: 1. The peptide of Sato et al. is identical to the peptide of either mouse or human. Thus, Sato et al.'s protein and peptide meets the claim limitations.

NO CLAIM IS ALLOWED.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

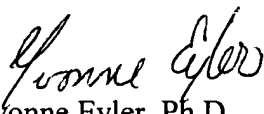
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne Eyler, Ph.D. whose telephone number is (703) 308-6564. The examiner can normally be reached on Monday through Friday from 830am to 630pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-2731. The fax phone number for this Group is (703) 305-3014 or (703) 308-4242.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [paula.hutzell@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


Yvonne Eyler, Ph.D.
Primary Examiner
February 15, 2000